



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/428,387	10/28/1999	ADAM MICHAEL FENNE	17954-15	4586

7590 06/01/2005

JOEL D VOELZKE  
HOWREY SIMON ARNOLD & WHITE LLP  
301 RAVENSWOOD AVENUE BOX NO.34  
MENLO PARK, CA 94025

EXAMINER
----------

VU, NGOC K

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/428,387

Applicant(s)

FENNE, ADAM MICHAEL

Examiner

Ngoc K. Vu

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19 and 43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is indefinite because there are no antecedent basis for the limitations "the after login viewing selection information of the first viewer" in lines 15-16, "the after login viewing selection information of the second viewer" in lines 18-19, "the delivered after login viewing selection information of the first viewer" in lines 22-23.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 43 is rejected under 35 U.S.C. 102(e) as being anticipated by Klug et al (U.S. 5,996,007 A).

Regarding claim 43, Klug discloses a presentation delivery method, comprising:

logging in by a user to a viewing station (e.g., computer – see col. 5, lines 8-10);

delivering a sponsored message (message many include advertising and promotional message or product information) over the Internet to the viewing station (see col. 5, lines 47-50);

Art Unit: 2611

pre-caching the delivered sponsored message at the viewing station (the message is downloaded prior to web site selection and stored in cache – see col. 5, lines 52-59);

delivering multimedia content (the web site) over the Internet to the viewing station (see col. 5, lines 12-31);

presenting the delivering multimedia content at the viewing station (see col. 5, lines 12-31); and

presenting the pre-cached sponsored message at the viewing station at a time when the multimedia content is at least substantially not available; wherein the multimedia content is not available because a downloading delay in the delivering of the multimedia content (presenting the message during the waiting time for downloading the web site – see col. 6, lines 56-62).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al. (US 6,487,538 B1) in view of Klug et al (U.S. 5,996,007 A).

Regarding claim 19, Gupta discloses an Internet message delivery method, comprising:  
a first/second user from one or more viewing stations (100, 200, 400) establishes a connection with the ISP or proxy to access the internet (see col. 9, lines 2-13 and figures 1-4C);  
delivering viewing behavior information (e.g., the requested sites or URLs) of a first/second viewer from one or more viewing stations which the first/second viewer is using to a processing system (ISP or proxy) wherein the processing system and the viewing station are operatively connected to each other through the Internet (see col. 9, lines 3-7, 38-43);

delivering demographic information regarding the first/second viewer to the processing system (when the user views a web page or completes any transactions on Internet, each and every user action is processed through the ISP or proxy. The ISP receives and maintains a user's profile consisting of demographic information see col. 9, lines 10-13, 17-24);

processing at the processing system the viewing selection information of the first/second viewer and demographic information regarding the first/second viewer delivered to the processing system to select a first/second viewer multimedia message targeted to the first/second viewer (the viewing selection information, e.g., the selected web site or URL, and demographic information are utilized to target advertisements to specific users by the ISP or proxy – see col. 6, lines 31-45; col. 8, lines 44-56);

delivering, responsive to the viewing selection information of the first viewer, the first multimedia message to a viewing station of the first viewer (delivering the targeted advertisement to the specific user based on his/her selected web site or URL – see col. 6, lines 31-45; col. 8, lines 44-56; col. 10, lines 56-61).

Gupta does not teach presenting the first viewer multimedia message when there is a downloading delay in the availability of the multimedia content. However, Klug discloses presenting the message or advertisement during the waiting time for downloading a selected web site (see col. 6, lines 56-62). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Gupta by presenting the message or advertisement during the waiting time for downloading a selected web site as taught by Klug in order to increase advertisement effectiveness and user enjoyment.

Gupta does not explicitly disclose logging in a first/second viewer. However, Klug discloses that the Internet session is initiated by a user by logging on to a computer at the user node (see col. 5, lines 5-10). Therefore, it would have been obvious to one having ordinary skill

in the art at the time the invention was made to modify the system of Gupta by including logging in feature as taught by Klug in order to identify user for authorizing accesses.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barrett et al. (US 6,412,112 B1) teaches a system for distributing and selecting a set of digital data to be distributed to a plurality of remotely located client terminals.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

Art Unit: 2611

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu  
Primary Examiner  
Art Unit 2611

May 23, 2005